REMARKS

Claims 11-29 and 37-44 are pending in the present application. In the Office Action dated August 13, 2004 the Examiner rejected claims 11, 23, 37 and 41 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement for the following limitations rejected in separate paragraphs of the Office Action:

(i) "an Email communication program on a server that performs the acts of receiving and indication of an Email communication;"

(ii) "if it is determined that multiple recipients have been indicated, storing a single copy of the Email communication on the server;"

(iii) "...notifying each of the multiple recipients of the electronic communication without sending the electronic communication to the recipients; "

(iv) "...sending the Email communication without waiting for a request for the Email communication;"

(v) "...retrieving notifying instructions for a recipient by the Email communication program;" and

(vi) "notifying instructions" alone.

The drawings were similarly objected to for not showing "receiving and an indication of an Email communication, or "if it is determined that multiple recipients have been indicated; storing a single copy of the email communication; or "if it is determined that multiple recipients have been indicated sending the Email communication without waiting for a request for the Email communication."

Claims 11, 23, 37 and 41 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite with respect to the difference between an "indication" and "notifying" in reciting "if it is determined that multiple recipients have been indicated, notifying each of the multiple recipients of the Email communication without sending the Email communication." Claims 18-22 were similarly rejected under § 112, second paragraph, for allegedly being indefinite as to whether "notifying instructions" is the same "as an indicator."

Claims 11-13, 16-24, 27-29, 37-39 and 41-43 were rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (U.S. Patent No. 6,067,561 in view of Arnold (U.S. Patent No.

6,275,848). Claims 14, 15, 25, 40 and 44 were rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (U.S. Patent No. 6,067,561 in view of Arnold (U.S. Patent No. 6,275,848 in further view of Foladare et al. (U.S. Patent No. 6,311,210). Claim 26 was rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (U.S. Patent No. 6,067,561) in view of Arnold (U.S. Patent No. 6,275,848) in further view of Landfield et al. (U.S. Patent No. 5,632,011).

Rejections under section 112, first paragraph, and Objections to the Drawings.

Applicant disagrees with the Examiner's rejections and objections, and requests reconsideration of in view of the following remarks.

As an initial matter with respect to the rejections under § 112, Applicant respectfully submits that the Examiner has improperly convoluted the distinction between the § 112, first paragraph, "written description" requirement and the "enablement requirement." The MPEP § 2163 (I) states that the "The first paragraph of 35 U.S.C., 112 requires that the 'specification shall contain a written description of the invention.' This requirement is separate and distinct from the enablement requirement." "To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention." MPEP 2163, citing *Vas-Cath Inc., v Mahurkar, 935 F.2d at 1563* (Fed. Cir. 1991). In contrast, "The test for enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." MPEP 2164.01, citing *United States v. Telectronics, Inc* 857 F.2d 778 (Fed. Cir. 1988).

Each of the Examiner's rejections under section 112, first paragraph, for alleged lack of enablement (and the objections to the drawings) appears to be based on a requirement that the specification or drawings describe the invention in the claims verbatim. There is no assertion by the Examiner that one of ordinary skill in the art is not able to make and use the claimed invention without undue experimentation based on the specification. Moreover, with respect to software, which is the field for the best mode for implementing the present invention, the Federal Circuit has held that "[a]s a general rule, where software constitutes part of a best

mode of carrying out an invention, description of such a best mode is satisfied by a disclosure the functions of the software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed. Thus, flow charts or source code listing are not a requirement for adequately disclosing the function of software." MPEP, 2164 (I)(A) citing *Fonar Corp. v. General Electric Co.*, 107 F.3d 1543 (Fed. Cir. 1997).

Accordingly, the Examiner's objections to the drawings should be withdrawn, as should the rejections for lack of enablement because whether the present claims can be implemented without undue experimentation has not been questioned in the present case. Applicant will accordingly proceed to address the rejections under section 112, presuming that the Examiner intended to draw the rejections under the written description requirement rather than the enablement requirement of § 112, first paragraph.

The Examiner's rejections under 112, first paragraph each appear to be improperly based on a requirement that the written description (or the drawings) describe verbatim what is recited in the claims. This is improper. "While there is no *in haec verba* requirement, newly added limitations must be supported in the specification through express, implicit or inherent disclosure." (MPEP, 2163(I)(B) Moreover, the Examiner has overlooked that the present claims use the same language as the original claims, or merely rephrase the language to clarify the invention. "It is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification." MPEP 2163.(I).

With respect to the rejection of claims 11, 23, 37 and 41 under section 112, first paragraph, the present amendment obviates this grounds of rejection. The Examiner stated that the specification does not support "...an Email communication program on a server that performs the acts of receiving and indication of an Email communication." The Examiner stated that "this limitation leaves one to believe that the a server will receive an Email communication, when in fact, it is a user or at least one recipient that will receive and indication of the an Email communication.

The Examiner's understanding is only partly correct. It is correct that the recipients receive an indication of the Email communication from the system (i.e. the program on the server), however, the system also receives indications of the email communication to be sent.

For example, at page 3, line 25-26 it is stated that the "[T]hat the system first receives an indication of the electronic communication to be sent and receives an indication of the recipient users." Moreover, item 703 in Figure 7 refers to "present currently stored message indicators to recipients." Storing the indicators is one form of receiving them. Thus there is support for the previously presented claim limitation. In any case, solely to further clarify, claims 11, 23, 37 and 41 have been amended to recite in pertinet form "...receiving ~~an indication of~~ an Email communication, including an indication of at least one recipient to receive the Email communication." Applicant submits this amendment, which goes to clarity rather than written support, obviates the Examiner's rejection on this ground.

Claims 11, 23, 37 and 41 were rejected under section 112, first paragraph for allegedly not providing support for the phrase "if it is determined that multiple recipients have been indicated, storing a single copy of the Email communication on the server." Applicants respectfully submit that there is implicit and explicit support for this limitation in specification as a whole and in the original filed claims.

First, the entire specification, including the Background section makes it clear that the context of the invention is for when multiple recipients are designated. For example to contrast with the problems of the prior art, at page 1, line 16 it is stated "For example, when an electronic message is to be sent to multiple recipients, current messaging systems deliver a separate copy of the message from the sender's system to each of the recipients' system...Each recipients system that receive the message is then responsible for storing and managing the message." By implication, the claimed method, which solves the problem by storing a single copy of the message, is used in cases when multiple recipients are designated.

Second, the originally submitted claims explicitly recited in pertinent form "when it is determined that multiple recipients have been indicated...." and/or "....for determining whether multiple recipients of the electronic communication have been indicated." Applicant submits that the terms "when" and "determining whether" as submitted with the original claims are ordinarily understood to have the same conditional meaning as "If" as presently recited in the claims. The amendment to use the word "If" in the response mailed July 27, 2003, was made to clarify the original meaning of the conditional terms "when" or "determining whether." For example a patent Examiner might state that "the claims will be allowed when they are

distinguishable over the art" or might state "my job is determining whether claims are distinguishable over the art before issuing a notice of allowance. In each case, the intent of "when" or "determining whether" has the same conditional meaning as "If". The originally submitted claims were amended to recite "If" to rephrase and clarify the intended meaning. Thus the term "If" does not add new matter because the original claims form part of the original specification. Because the term "If" is supported by the meaning of the original conditional terms, "when" or 'determining whether", there is support in the specification for this limitation and the rejection on this ground should be withdrawn.

With due respect to the Examiner, the statement at the end of paragraph 6 of the Office Action that the specification "...would leave one to believe that a recipient could have a copy of original Email communication stored in a different location exclusive to the recipient" is not on point. This is an option available for users that can be invoked subsequently to the Email programming storing a single copy of the save message if it is determined that multiple recipients have been indicated.

The foregoing also addresses the further grounds of rejection of the same limitation stated in paragraphs 7-8 of the Office Action, which is aimed at the same subject matter in conjunction with "notifying each of the multiple recipients of the electronic communication without sending the electronic communication ot the recipients." The originally submitted claims recited the conditional terms "when" or "determining whether" along with the acts of notifying each of the multiple recipients of the electronic communication without sending the electronic communication to the recipients." No further description is required because the claims are part of the original description, and the subject matter is the function performed by software. Moreover, "There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed." MPEP 2163.01(I)(A). Hence, the claims filed in the original specification provide the needed written support for the claim limitations therefore, the further rejection of the claims on this ground should be withdrawn.

The original claims also supported the limitations mentioned at paragraphs 9-14 of the Office Action. In each case, the Examiner has rejected terms in the original claims because those terms were not verbatim recited in the specification. Again, because the terms were in the originally filed claims, which form part of the specification, there is adequate support

for the claims. Again, with respect to the question of enablement, the claim terms do not require any further description in the specification to enable one of ordinary skill in the art to design an Email communication program with the recited limitations, because implementation is simply a matter of one of ordinary skill in the art writing code to perform the recited acts.

The rejections under section 112, second paragraph.

Applicant disagrees with the Examiner's statements with respect to claims 11, 23, 37 and 41 that it is misleading to if [sic] there are two different types of indicators or notifications. Furthermore, the specification makes no distinction as to an indicator or a notification." These statements do not give credit to the ordinary meaning of terms or to the teachings in the specification. The specification refers to both indications and notifications in many contexts. Using plain meaning, one of ordinary skill in the art would understand that an "indication" differs from "notifying". An "indication" in the context of "If it is determined that multiple recipients have been indicated" as recited in the claims 11, 23, 37 and 41, means information that is less than an entire Email communication and particularly regarding the number of recipients. Such information may, for example, be contained in the "To" line of an email address. A "notification" on the other hand (or more precisely, the act of "notifying") is sending a recipient information regarding the existence of the Email, but which is less than the whole Email (*i.e.,* without sending the Email communication to the recipients). Thus it is clear from claims 11, 23, 37 and 41 that the recited "indication" is information regarding whether multiple users are designated, and "notifying" is the act of sending something to the user to apprise of the existence of Email without sending the whole Email communication. One of ordinary skill in the art understands that a notification may include an indication, although the act of notifying is distinct from the indication per se. Therefore, withdrawal of the rejection of claims 11, 23, 37 and 41 on under § 112, second paragraph, for alleged indefiniteness is requested.

Applicant also disagrees with the Examiner's rejection of claims 18-22, under section 112, second paragraph for reciting the limitation "notifying instructions." Again, the Examiner appears to be improperly seeking a verbatim description of "notifying instructions." The plain meaning of "notifying instructions" is instructions (i.e., acts to take) to notify a recipient. The specification plainly teaches, for example, at page 9, lines 6 and following: "As

discussed in greater detail with respect to Figure 2, the Message Tracking Table stores information that instructs the MDS system on how and when to send messages and indicators to recipients and stores record of when actions were taken or of the instructions from recipients." At page 10, line 11and following the specification teaches. "When the user indicates that they wish to review a message corresponding to a message indicator, the Message Receiver uses the message reference information in the message indicator to retrieve the stored messages. Applicants submit that it is clear from the specification and plain meaning, that "notifying instructions" are instructions about how and when to send a message to a user. Therefore, withdrawal of the rejections of claims 18-22 under section 112, second paragraph, is requested.

Rejections over the Cited Art

Applicants disagree with the Examiner's rejections of the claims as obvious over Dillon in view of Arnold or further in view of Foladare.

Dillon is directed to sending notifications (alerts) of Email messages to recipient's using a hybrid network that transmits notifications via a continuous high speed channel. Other than these features and in particular, the features regarding how the alerts are sent, the handling of messages as taught by Dillon is conventional in the art. In this regard, Applicant respectfully submits that the Examiner has read more into Dillon than is taught therein and/or has not properly characterized the teaching of that reference, especially in comparison to Applicant's embodiments.

First, and most importantly, as the Examiner acknowledges "Dillon does not specifically teach determining by the Email communication program, whether multiple recipients of the Email communication have been indicated in the received indication." This is true. In fact, Dillon does not teach *anything whatsoever* about storing an Email message based upon anything that has to do with whether multiple recipients have been indicated. In this regard, the cited passages of Dillon, at most teach storing an email message if the user has not accessed the Email account, not requested the Email, or is not online. This is common in the prior art. If multiple recipients were designated, in the system described by Dillon, multiple email messages would be stored for each recipient.

Second, because Dillon is silent about indications of multiple recipients, it is axiomatic that Dillon does not teach "notifying *each of the multiple recipients* of the Email to

communication [sic] without sending the Email communication to the recipients." Dillon makes no references at all to multiple recipients for the same Email communication. Therefore, the acts of storing a single copy of the message if multiple recipients have been indicated is not taught or suggested by Dillon.

The only elements Dillon teaches that are relevant to Applicant's embodiments is storing an email message and sending a notification of the Email message to a recipient without sending the Email message. Accordingly, with all due respect, the Examiner's characterization of the elements taught by Dillon is not accurate. Dillon at most teaches storing an email message and sending a notification of the message to a recipient, *e.g.*, "You've got mail. " Any prior art Email system does this.

The deficiency of Dillon is not cured by combination with Arnold. Arnold was cited for teaching "determining whether multiple recipients of the Email communication have been indicated in the received indication. (col 4, lines 25-col. 5, line 25)." Applicant acknowledges that Arnold teaches determining whether multiple recipients of the Email communication have been indicated. However, Arnold does not teach storing the Email message, based upon whether multiple recipients have been indicated. Indeed, Arnold teaches nothing at all about treating the Email message based upon whether multiple recipients have been indicated. What Arnold teaches at the cited passages and elsewhere, is detaching attachments from Email messages based on size (or other criteria), storing the attachment on the Internet, sending all the designated recipients the Email message devoid of the attachment, but with an embedded URL link, and allowing the recipients access to the stored attachment through the link embedded in the Email message. These features are not conditionally based on whether multiple users have been indicated or not.

Accordingly, the combination of Arnold with Dillon fails to teach or suggest the combination of elements in the various embodiments disclosed by Applicant.

In addition, the motivation for combining Arnold with Dillon stated by the Examiner is not supported by the teaching in Arnold or Dillon, but rather by hindsight reading of those references in view of the present Application. The motivation for combining the references stated by the Examiner is "because it would be more efficient for a system to acknowledge when multiple recipients have been indicated so if the sender needed to know

which recipients did not receive an Email, the sender could resend the Email to the recipients that are missing the Email or have misplaced it." Applicants submit that this motivation is supplied by the Examiner not by the references, because no such efficiency is taught, suggested, or stated to be desirable in the systems described by Arnold and Dillon. Neither reference discusses efficiency based on whether multiple recipients have been indicated or resending Email to recipients that are missing or have misplaced the Email. These advantages are however, a benefit of Applicant's invention. It is impermissible hindsight to read the prior art in light of the disclosed invention to find a motivation in the prior art to do what Applicant has done.

Moreover, even if one would combine Arnold and Dillon for other reasons, these reasons would not lead one of ordinary skill in the art to the same. Dillon is directed toward sending notifications (alerts) of Email messages to recipient's using a hybrid network that transmits notifications via a continuous high speed channel, while Arnold is directed toward a method of detaching attachments from Email messages, storing the attachments on the Internet and sending a notification message with an embedded URL address for the stored attachment to the recipients. The combination of Arnold and Dillon might provide motivation to one of ordinary skill in the art to send notifications devoid of attachments described by Arnold using the continuous high speed channel taught by Dillon. This is not relevant to, and does not suggest, storing a single copy of the email message based on whether there is an indication of multiple users. Therefore, even accepting the proposed motivation asserted by the Examiner, the combination of references would not yield all the elements of Applicant's claims as recited in the combination of acts that are taken.

Neither Foladare nor Landfield cure the deficiencies of Dillon and Arnold. These references also fail to disclose anything regarding determining whether multiple recipients of an Email have been indicated, and on that basis, storing a single copy of the Email and sending only a notification to the recipients. Foladare merely teaches a program that automatically deletes emails if they have been received by at least one of the electronic mail receiving devices. In this regard, the Examiner has mischaracterized Foladare. Foladare does not teach deleting a single stored copy of an email when none of the recipients have indicated that the email be saved, because Foladare, teaches sending the full Email to email receiving devices. There is no teaching whatsoever about deleting email according to acts taken (or not taken) by multiple

recipients. Thus Foladare has been improperly cited for what it teaches in a "parts" approach to examination, i.e., to search for a part of the teaching of Applicant in a reference, no matter how small, to support an obviousness rejection. Landfield was similarly cited for teaching a part, i.e., for sending and Email communication to a non-recipient authorized to receive the email. There is nothing in these references that suggest the combination of storing a single copy of the email message based on whether multiple users are indicated, hence the additional parts taught by Foladare and Landfield are merely indicative of parts known in art, and do collectively suggest all the elements, nor the particular combination of elements in Applicant's invention.

Accordingly, the Examiner's rejections of the claims as obvious over Dillon and Arnold, or further in view of Foladare and Landfield do not establish a prima facie case of obviousness at least because:

(1) the combined references do not teach all the elements of the claims, specifically, none of the references teach or suggest storing a single copy of an Email communication conditionally *based on whether multiple recipients have been indicated*;

(2) there is no motivation from within the references to combine their teaching - and the combined teaching of those references would at most lead to embodiments that differ from Applicants embodiments. Dillon and Arnold are directed to sending messages over a high speed channel, and to detaching attachments from messages, respectively. Neither has anything to do with storing messages based on an indication of the number of recipients. Dillon stores messages based on whether the user has accessed the message or not, and the Arnold is stores messages based on size (*i.e.*, the presence of attachments);

(3) impermissible hindsight has been used in asserting motivations to combine the references. More particularly, the Examiner has recited the advantages of Applicants' invention to provide the motivation to combine the teachings of Dillon and Arnold for reasons that are not taught or suggested in either reference;

(4) a toolbox "parts" approach has been taken in rejecting the present claims. The Examiner has cited Foladare and Landfield solely for their alleged teaching of automatically deleting email messages and for sending email messages to authorized non-recipient users, respectively. Any email program typically provides such features, but not in combination with the other elements of Applicants invention.

Accordingly, the rejections of the claims as obvious over Dillon and Arnold, or further in view of Foladare and Landfield should be withdrawn.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a timely Notice of Allowance are earnestly solicited.

Respectfully submitted,

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